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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/035,712

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Richard A. Morris

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EXAMINER

FERNANDEZ RIVAS, OMAR F

ART UNIT

PAPER NUMBER

2129

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,712

Applicant(s)

MORRIS ET AL.

Examiner

Omar F. Fernández Rivas

Art Unit

2129

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 13-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13-21 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to an AMENDMENT entered May 8, 2006 for the patent application 10/035,712 filed on November 8, 2001.
2. The Office Actions of February 25, 2006, July 14, 2005, January 4, 2005 and July 28, 2004 are fully incorporated into this Final Office Action by reference.

Status of Claims

3. Claims 2, 3, 13, 14, 23 and 24 have been amended. Claims 2-11, 13-21 and 23-31 are pending on this application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-11, 13-21 and 23-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Weinberg et al (US Patent #6,587,969, referred to as **Weinberg**).

Claims 2, 13 and 23

Weinberg anticipates a method, a system and software for selecting members in a hierarchy, the method performed using a computer system comprising one or more processing units and one or more memory units (**Weinberg**: Abstract, L6-15;

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Examiner's Note (EN): a tree is a hierarchy, nodes are members of the tree), the method comprising:

receiving input of a user from a member selection interface (**Weinberg**: Abstract, L8-15; C2, L41-56; C5, L52-59; C26, L4-19);

determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data (**Weinberg**: Abstract; C2, L41-56, C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: a dimension is a particular field or screen object of the server screen)

recording the sequence of actions of the user in a member selection script (**Weinberg**: Abstract 1-3; C2, L23-26, C5, L27-31; C21, L35-65; Figs. 1, 6A, 6B, 6C EN: user steps taken during a user session is a sequence of actions of the user. Storing the user steps (or member selections) in memory as a testscript is recording the user actions in a member selection script); and

executing the recorded member selection script to generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified (**Weinberg**: Abstract; C2, L23-40, C3, L11-36; C5, L24-65; C8, L40-67; C25, L20-49; Fig. 2; EN: modifying nodes is modifying the members).

Claims 3, 14 and 24

Weinberg anticipates one or more of the actions comprise selecting the dimension from which members are to be selected, the dimension selected from the group consisting of a product dimension, a geography dimension, and a time dimension (**Weinberg**: Abstract, L12-15; C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting the screen objects or fields is selecting the dimensions).

Claims 4, 15 and 25

Weinberg anticipates one or more of the actions comprise selecting the hierarchy from which members are to be selected (**Weinberg**: Abstract, L12-15; C3, L11-36; C11, L34-45; Figs. 2, 3B, 4B, 4D; EN: selecting the screen objects or fields is selecting the hierarchy).

Claims 5, 16 and 26

Weinberg anticipates selecting or deselecting one or more levels of the hierarchy from which members are to be selected, the members being selectable only from selected levels (**Weinberg**: C3, L14-20; C9, L7-16; C17, L1-26 Figs. 2, 3A, 3B, 4B, 4D, 5D, 5F; EN: nodes on a tree can only be selected in levels depending on their location in the hierarchy).

Claims 6, 17, and 27

Weinberg anticipates expanding a member to view the children of the member; and
the selection of an expanded member causing only the selection of the expanded member (**Weinberg**: C9, L1-16; C17, L1-26; Figs. 3A, 3B, 4B, 4D, 5E).

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Claims 7, 18 and 28

Weinberg anticipates collapsing a member to hide the children of the member;
and
the selection of a collapsed member causing the selection of the expanded member and
the children of the expanded member (**Weinberg**: C9, L1-16; C17, L1-26; Figs. 3A, 3B,
4B, 4D, 5E).

Claims 8, 19 and 29

Weinberg anticipates selecting or deselecting one or more members from the
hierarchy (**Weinberg**: Abstract, L12-15; C3, L11-23; C9, L1-16; C17, L1-26; Figs. 3A,
3B, 4B, 4D, 5E).

Claims 9, 20 and 30

Weinberg anticipates the one or more actions are recorded in the member
selection script using one or more commands, the commands and one or more
parameters associated with each command identifying the one or more actions
(**Weinberg**: Abstract, L1-3; C2, L23-56; C21, L22-65; Figs. 6A, 6B, 6C).

Claim 10

Weinberg anticipates the user manually generates the member selection script
(**Weinberg**: Abstract, L1-3; C2, L23-56; C5, L27-31; C25, L20-49; Fig. 1; EN: if the user
is making selections, he is manually generating the script or protocol to follow).

Claims 11, 21 and 31

Weinberg anticipates the member selection script is automatically generated based on input received from the user using a member selection interface (**Weinberg**: C21, L22-67, C22, L 1-36; Figs. 6A, 6B, 6C).

Response to Applicant's arguments

Rejection under 35 U.S.C. § 101:

In light of the amendments made by the Applicant, the rejection under 35 U.S.C. § 101 is withdrawn.

Rejection under 35 U.S.C. § 102(e):

5. The Applicant is reminded that it is the Examiner's duty to examine each claim in the broadest reasonable manner.

In reference to Applicant's arguments:

The Applicants respectfully submit that Weinberg has nothing to do with amended independent claim 2 limitations regarding a "computer-implemented method for selecting members in a hierarchy" and in particular Weinberg has nothing to do with amended independent claim 2 limitations regarding "receiving input of a user from a member selection interface".

Examiner's response:

The Weinberg reference describes a method for testing a transactional server, which must be implemented in a computer. The test is displayed (interface) to the user as a tree having nodes (members). The user is able to edit nodes (receive input of a

user to a member) on the tree to modify the test. Thus the user interface provided by Weinberg provides the member selection interface (selecting nodes in the tree to edit) that receives an input from a user as claimed by the Applicant.

In reference to Applicant's arguments:

The Applicants further submit that Weinberg has nothing to do with amended independent claim 2 limitations regarding "determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data".

Examiner's response:

The user selects nodes (members) from a particular server screen (a particular dimension of an organization of data) as stated on column 3, lines 11-36 of Weinberg. Moreover, on column 5, lines 11-20, it describes the test as representing a single business process, which is a particular dimension of an organization of data. Also on Figures 2 and 4B, it can be seen how each node represents a set of related (associated) data (a particular dimension of an organization of data)

In reference to Applicant's arguments:

The Applicants still further submit that Weinberg has nothing to do with amended independent claim 2 limitations regarding "recording the sequence of actions of the user in a member selection script". Rather, Weinberg discloses a testing tool for testing the functionality of a transactional server where a recorder module merely records a series of user steps. (Abstract, Figures 6A-6C). The testing tool in Weinberg merely displays

these recorded user steps to allow for verification of expected server responses and fails to disclose, teach or even hint at recording the sequence of actions, as recited in Applicants claims. (Abstract). In fact, Weinberg teaches away from the claimed invention because the recorder module of Weinberg merely records the particular members that the user selects, i.e. business process steps. (Figures 6A-6C). Thus, Weinberg cannot provide for "recording the sequence of actions of the user in a member selection script", since Weinberg does not even teach, suggest, or hint at recording the sequence of events (actions) that the user went through to determine the members that are selected.

Examiner's response:

The Weinberg reference teaches recording the user steps (sequence of actions of the user) taken during a user session (**Weinberg**: abstract: L1-3). The user edits the test by editing nodes on the tree and these changes (user steps) are stored as a testscript (**Weinberg**: C21, L35-65). The reference does not teach away from the Applicant's invention since it does record or stores the actions taken by the user.

In reference to Applicant's arguments:

The Applicants yet further submit that Weinberg has nothing to do with amended independent claim 2 limitations regarding "executing the recorded member selection script to generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified". Rather, Weinberg discloses creating a test script when the recorder module records the particular members that the user selects. (Figures 6A-6C).

Weinberg merely discloses a hard coded set of members used to perform a particular business process which may become out of date and have to be recreated when members of Weinberg's hierarchical dimension are added or deleted. Weinberg does not disclose, teach, or suggest executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user's original intent. Thus, Weinberg cannot provide for "executing the recorded member selection script to generate a new selection of members based upon the members and hierarchical relationships of the users original inputs, after the hierarchy of members has been modified", since Weinberg does not even provide for (1) recording the sequence of events (actions) that the user went through to determine the members that are selected; or (2) executing this sequence of events (actions) once the hierarchy is modified and thereafter produce a new selection of members that satisfies the user's original intent.

In addition, the Examiner equates "after the hierarchy of members has been modified" recited in amended independent claim 2 with modifying nodes disclosed in Weinberg. (23 February 2006 Office Action, Page 4). However, modifying nodes disclosed in Weinberg is merely provided for editing properties of the nodes to modify the test and has nothing to do with after the hierarchy of members has been modified. (Column 25, Lines 20-49). In contrast, "after the hierarchy of members has been modified" recited in amended independent claim 2 is related to recreating the desired member selections when the underlying hierarchical structures change. Thus, the Applicants respectfully submit that the equations forming the foundation of the

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Examiner's comparison between Weinberg and amended independent claim 2 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent claim 2 from Weinberg.

Examiner's response:

In the method of Weinberg, the nodes (members) are edited (modified) to edit the test. These modifications made by the user are recorded and then "played back" (executed) (**Weinberg**: C2, L23-40). The results of the test are displayed to the user as a hierarchical node structure (**Weinberg**: C3, L11-36). Thus a new selection of members is generated based on the user's inputs (the editing made on the nodes) after the hierarchy of members (the tree) has been modified (by modifying the nodes on the tree).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Correspondence Information

7. Any inquires concerning this communication or earlier communications from the examiner should be directed to Omar F. Fernández Rivas, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-2589 or email omar.fernandez_rivas@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, David Vincent, may be reached at (571) 272-3080.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Omar F. Fernández Rivas
Patent Examiner
Artificial Intelligence Art Unit 2129
United States Department of Commerce
Patent & Trademark Office

Tuesday, July 18, 2006

ofR

David Vincent 7/23/06
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SUPERVISORY PATENT EXAMINER